

REMARKS/ARGUMENTS

Favorable reconsideration of this application in view of the above amendments and in light of the following discussion is respectfully requested.

Claims 1-12 and 14-20 are pending. Claims 1 and 12 are amended.¹ No new matter is introduced.²

In the outstanding Office Action, Claims 1-7 and 12 were rejected under 35 U.S.C. § 112, second paragraph as indefinite. In addition, Claims 1, 3-14, and 20 were rejected under 35 U.S.C. § 102(a) as unpatentable over Suzuki (SUZUKI, Shigeru et al., "A New Ionization Method for the LC/MS of Wastes and Related Compounds", Japan Society for Environmental Chemistry, Pages 764 to 765, 2003.); Claim 2 was rejected under 35 U.S.C. § 103(a) as unpatentable over Suzuki in view of Kobayashi (Japanese Patent Publication No. 2002-015968); Claims 15 and 16 were rejected under 35 U.S.C. § 103(a) as unpatentable over Suzuki in view of Sakairi (Japanese Patent Publication No. 2001-093461); and Claims 17, 18, and 19 were rejected under 35 U.S.C. § 103(a) as unpatentable over Suzuki in view of Mimuri (Japanese Patent Publication No. 02-135655).

In rejecting Claims 1-7 and 12 as indefinite, the outstanding Office Action states that "The limitation of 'a chemical substance having low ionization probability' renders the claim indefinite because it is unclear what ionization probability values would be considered "low."

¹ Claims 1, 8, 12, and 19 were previously amended under PCT Article 34 during the international preliminary examination phase. These amendments were annexed by the International Preliminary Examining Authority to the international preliminary examination report (IPER) and they were communicated to the elected Offices. An English translation of these annexes was properly submitted with the filing of the U.S. national stage application (See M.P.E.P. § 1893.01(a)(3)). Therefore, these amendments should have been entered into the U.S. national stage application by the U.S. Patent and Trademark Office. Accordingly, Claims 8 and 19 are identified as "previously presented." (See M.P.E.P. § 714(II)(C)(A), which states that "claims that were amended or added under PCT Article 19 or 34 with effect in the U.S. national stage application must have the status identifier (previously presented)").

² Support for amended Claims 1 and 12 can be found in Claim 13 as originally filed and at least at page 15, lines 10-17 of the specification as originally filed, for example.

Some examples of substances that the applicant considers to fall into this category are given in the specification, such as polycyclic aromatic hydrocarbons, oxine copper, halogenated hydrocarbons, and aromatic nitro compounds (p. 15), but these are given as examples, indicating that the list is not exhaustive.”³ Amended independent Claim 1 and amended dependent Claim 12 incorporate the subject matter previously recited in dependent Claim 13, and therefore recite that the chemical substance is an aromatic nitro compound, oxine copper, halogenated nitrobenzyl, or a polycyclic aromatic hydrocarbon. Therefore, the scope of amended independent Claim 1, the claims depending therefrom, and amended dependent Claim 12 is believed to be definite. Accordingly, it is respectfully requested that the rejection of Claims 1-7 and 12 under 35 U.S.C. § 112, second paragraph be withdrawn.

The rejections of Claims 1-20 under 35 U.S.C. §§ 102(a) and 103(a) that are based on Suzuki are traversed.

Suzuki does not qualify as prior art under 35 U.S.C. § 102(a) because Suzuki was published within one year of the filing dated of the present application and the ionization method and associated apparatus described on pages 764 and 765 of Suzuki describe Applicant’s own work. As noted in M.P.E.P. § 2132.01 “Applicant’s disclosure of his or her own work within the year before the application filing date cannot be used against him or her under 35 U.S.C. 102(a).”⁴ M.P.E.P. § 2132.01 further notes that

Therefore, where the applicant is one of the co-authors of a publication cited against his or her application, the publication may be removed as a reference by the filing of affidavits made out by the other authors establishing that the relevant portions of the publication originated with, or were obtained from, applicant. Such affidavits are called disclaiming affidavits. *Ex parte*

³ See the outstanding Office Action at page 2, lines 11-17.

⁴ See also *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982)

Hirschler, 110 USPQ 384 (Bd. App. 1952). The rejection can also be overcome by submission of a specific declaration by the applicant establishing that the article is describing applicant's own work. *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).

Submitted herewith are three identical affidavits that are each signed by a respective one of the individuals listed as co-authors of Suzuki. In the affidavit, Shigeru Suzuki, the inventor of the present application, declares that the ionization method and associated apparatus described on pages 764 and 765 of Suzuki describe his own work. Shinichi Sakai and Akio Yasuhara, who are each listed as co-authors of Suzuki, each declare that the ionization method and associated apparatus described on pages 764 and 765 of Suzuki originated with, or were obtained from, Shigeru Suzuki. It is submitted that these affidavits establish that Suzuki is Applicant's disclosure of his own work within the year before the application filing date, and therefore cannot be used against him or her under 35 U.S.C. § 102(a).

Accordingly, as Suzuki does not qualify as prior art under 35 U.S.C. § 102(a), Applicant submits that Suzuki also does not qualify as prior art with respect to the present application under 35 U.S.C. § 103(a). It is respectfully requested that the rejections of Claims 1-20 under 35 U.S.C. §§ 102(a) and 103(a) based on Suzuki be withdrawn.

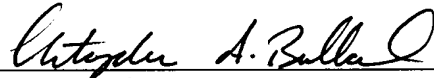
For the reasons discussed above, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal allowance. Therefore, a Notice of Allowance for Claims 1-12 and 14-20 is earnestly solicited.

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Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representative at the below listed telephone number.

Respectfully submitted,

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